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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,954	07/11/2005	Andrew Holmes	30873/300367	8639
4743 7590 06/09/2009 MARSHALL, GERSTEIN & BORUN LLP 233 SOUTH WACKER DRIVE 6300 SEARS TOWER CHICAGO, IL 60606-6357				
EXAMINER YAMNITZKY, MARIE ROSE				
ART UNIT		PAPER NUMBER		
1794				
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06/09/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/511,954

Applicant(s)

HOLMES ET AL.

Examiner

Marie R. Yamnitzky

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 Jan 2009, 05 Mar 2009 and 06 Mar 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-46, 48-75, 78-80 and 82-97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-46, 48-75, 78-80 and 82-97 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 05 Jan 2009
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. This Office action is in response to applicant's amendment filed March 05, 2009, which amends the specification and claims 32, 43, 48, 49, 51, 65, 74 and 97, and cancels claims 47, 76, 77 and 81.

Claims 32-46, 48-75, 78-80 and 82-97 are pending.

2. This Office action is also in response to the Rule 131 Declaration of Christopher Kay, filed March 06, 2009.

3. The references listed in the Information Disclosure Statement filed January 05, 2009 have been considered by the examiner and are made of record. The listed reference which was previously made of record has been lined through.

4. The objection to the disclosure for reasons set forth in the Office action mailed September 05, 2008 is overcome by amendment. However, the amendment appears to introduce an error into the specification. See the objection to the disclosure as set forth later in this action.

The objection to claims 74 and 97 under 37 CFR 1.75(c) is overcome by amendment.

The rejection of claims 76, 77 and 81 under 35 U.S.C. 112, 2nd paragraph, is rendered moot by claim cancellation.

5. The disclosure is objected to because of the following informalities:

In the replacement paragraph filed March 05, 2009, an error appears to have been introduced into the first formula in the second row of reaction schemes (see the line extending to the lower left from the benzene ring).

Appropriate correction is required.

6. Claims 87-90 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for reasons of record in the Office action mailed September 05, 2008.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 32-46, 48-75, 78-80 and 82-97 stand rejected under 35 U.S.C. 102(e) as being anticipated by Ikehira et al. (US 2002/0193532 A1) for reasons of record in the Office action mailed September 05, 2008.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 32-46, 48-75, 78-80 and 82-97 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ikehira et al. (US 2002/0193532 A1) for reasons of record in the Office action mailed September 05, 2008.

11. Applicant's arguments filed March 05, 2009 have been fully considered but they are not persuasive with respect to the rejections that are maintained in this action.

With respect to the rejection of claims 87-90 under 35 U.S.C. 112, 2nd paragraph, applicant references portions of the specification and argues that the bounds of "substantially conjugated" would be readily understood by one skilled in the art when read in light of the specification. The examiner respectfully disagrees. While the specification discusses effects of conjugation length, the specification does not adequately describe the metes and bounds of the phrase "substantially conjugated". While "substantially conjugated" is less than "fully conjugated", insufficient guidance is provided to determine at what point a partially conjugated polymer or oligomer is considered to be "substantially" conjugated.

With respect to the rejections under 35 U.S.C. 102(e) and 103(a), the declaration filed on March 06, 2009 under 37 CFR 1.131 has been considered but is ineffective to overcome the Ikehira et al. reference.

The declaration under 37 CFR 1.131 is not signed by all (or by any) of the inventors. While the declaration states that the person who signed the declaration is authorized to make the statement of behalf of the assignee, there is no indication in the declaration as to why the assignee, rather than the inventors, is making the declaration. The assignee or other party in interest may make an affidavit or declaration under 37 CFR 1.131 when it is not possible to produce the affidavit or declaration of the inventor, but it is not clear if that is the situation in this case.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Ikehira et al. reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Ikehira et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

In the Rule 131 Declaration, the statement is made that the evidence submitted demonstrates that the inventors possessed at least as much as is shown in the Ikehira et al.

reference “at least as early as May 25, 2002”. This is insufficient to establish conception and reduction to practice of the invention prior to the effective date of the Ikehira et al. reference. The effective date of the Ikehira et al. reference is March 25, 2002. (The examiner notes that even if each occurrence of “May 25, 2002” in the declaration instead read --March 25, 2002--, the statements in the declaration would be insufficient because a date that is “at least as early as” may be the same as, rather than prior to, the effective date of the reference.)

Further, the statements indicating that the inventors possessed at least as much as is shown in the reference does not establish conception and reduction to practice of the invention. Possession is not synonymous with conception and reduction to practice.

Even if the evidence provided as Attachment “A” was completed prior to March 25, 2002 (the effective date of the Ikehira et al. reference), and presuming for the sake of argument that the evidence establishes what was conceived of and reduced to practice, rather than merely possessed, by the inventors, the evidence submitted does not establish conception and reduction to practice commensurate in scope with what is claimed in the rejected claims and shown in the Ikehira reference. The subject matter within the scope of the present claims that is disclosed and/or suggested by the Ikehira et al. reference is not limited to what is shown in Attachment “A”. The evidence submitted appears to show, at the most, polymers (and their related monomers, processes and electroluminescent devices), made from a monomer of general formula (V) of the claims wherein the organometallic group is $\text{Ir}(\text{ppy})_2\text{acac}$, and a comonomer that provides a 2,7-linked 9,9-disubstituted fluorene repeating unit. None of the claims are so limited, and some of the claims do not encompass such subject matter (e.g. claims 42-44 and 55-

57). The claims encompass much more than what is shown in Attachment "A". Ikehira et al. disclose and suggest much more within the scope of the claims than what is shown in Attachment "A". For example, Attachment "A" does not appear to provide any evidence related to claim embodiments wherein the polymer is made from a monomer of general formula IV, whereas the Ikehira et al. reference includes disclosure relevant to such embodiments.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (571) 272-1531. The examiner works a flexible schedule but can generally be reached at this number from 7:00 a.m. to 3:30 p.m. Monday and Wednesday-Friday.

The current fax number for all official faxes is (571) 273-8300. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (571) 273-1531.)

/Marie R. Yamnitzky/
Primary Examiner, Art Unit 1794

MRY
June 07, 2009